UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/149,216	09/08/98	MINAKUCHI	Y 21.1757-C-DI

WM01/1025

STAAS & HALSEY
700 ELEVENTH STREET, N.W., SUITE 500
WASHINGTON DC 20001

EXAMINER	
MENGISTU, A	
ART UNIT	**PAPER NUMBER**
2673	15

DATE MAILED: 10/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/149,216	Yu MINAKUCHI et al
Examiner	**Art Unit**
AMARE MENGISTU	2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Aug 27, 2001*

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *11-48, 55-60, 71-76, 83-91, 101, and 102* is/are pending in the applica

4a) Of the above, claim(s) *61-70, 77-82, 92-100, and 103-110* is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *11-15, 19-48, 55-60, 71-76, 83-91, 101, and 102* is/are rejected.

7) ☒ Claim(s) *16-18* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Claims 49-54,61-70,77-82,92-100,103-110 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group , there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. #14.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11-48,55-60,71-76,83-91,101-102 are rejected under the judicially created doctrine of double patenting over claims 11-42 of U. S. Patent No. 5,844,547 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as

follows: *"sensing characteristics of a touching contact on the touch panel"; "storing object data"; "storing display information"; "responding to the touch panel information"; "generating a touch report.."; " in response to the touch report and the recognized , simulated manuplation provided thereby.." etc..*

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "*a manipulation type of* **"elastic"**; must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 U.S.C. § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of the claim 18 *"the touching contact touches the object coming in a direction toward the object "* is not clear. What coming object is the applicant referring to?

The phrase "at a **speed higher than a predetermined speed**...the object image moves a distance in the direction and at a **speed proportional to the speed with which the touching contact** touches the object" is also confusing. The applicant recites the touching speed being higher than the predetermined speed and also the speed proportional to the couching contact. It is not clear the speed of the touching image.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 44 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ohuchi (4,903,012).

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims **11,15,23-34,36-37,39-48, 55-60, 101-102** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al** (55,060,135) in view of **Santo et al** (4,947,156) and **Ohuchi** (4,903,012).

As to claims; **11,15,23-34, 36-37,39--48, 55-60, 101-102 Levine et al** discloses a simulating manipulation of an object utilizing a display image comprising: sensing touching contact relative to the displayed image of the object, the touching contact simulating a manipulation of the object, and outputting touch information corresponding to the sensed touching contact (col.4, lines 30-40); detecting from the output touch information characteristics of said touching contact including the selecting location on the object image of the touching contact and changed of the touching contact and recognizing therefrom the corresponding object manipulation simulation (col.5, lines 61 - col.6, lines 5); changing the display of the object image in accordance with the recognized, simulated manipulation of the object (col.3, lines 32-41), storage memory (col.26, lines 11-16), Levine et al also disclose that the object image is in a state of distortion/or restoration (col.3, lines 32-41, as recited in claims 23,24,39 and 42).

Levine et al for simulating manipulation of an object utilizing an image on an electronic table, but has failed to teach that the manipulated image is on a display. However, the patent of **Sato et al** clearly teaches that it is well known for to display the manipulated image of the table on LCD or El display panel (Col.1, lines 10-16; col.3, lines 25-29).

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to have been motivated to have used Sato et al's methods of integrating the writing table and a display panel into the system of **Levine et al** 's display system, because this will allow the user to save space by integrating the writing table and the display .

Levine et al states a physical memory (col.26, lines 11-16) but did not explicitly disclose a storage medium storing a process . The patent of Ohuchi clearly teaches that a storage medium storing a process displaying an image of the object by detecting a position of touching contact reactive to the object image (col.2, lines 32-34, lines 60-col.2, lines 20). Ohuchi did not explicitly teach storing the object's central gravity. However, one skill in the art would have recognized that the storage deice of Ohuchi must store the image object including the central gravity of the object.

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to have used the storage medium of Ohuchi into the device of **Levine et al**, because this will allow the Levine's system to store the detected position of the image and to indicate the movement of the object .

9. Claims 12,35,71-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine** et al in view of **Santo et al** (4,947,156) and **Dunthorn (4,914,624)** .

As to claims 12,35,71-76 Levine (as modified by Sato et al) discloses moving and stopping the image on a display surface of the display device (col.12, lines 7-24), but has failed to two teaching contacts are located at opposite side of the object image. However, Dunthorn clearly teaches that it is well known for a touch screen display device to have two touch contacts (22,29) located at opposite sides of the object image (26) (see, fig. 1 (22,26,29)).

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to have been motivated to have incorporated Dunthorn's system of two contacts locations opposite to the object image into the device of **Levine et al** 's display system, since this is an alternative methods of data input for a touch screen display deice.

11. Claims 19-22,38,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al** (55,060,135) in view of **Santo et al** (4,947,156) and **CHARWAT** (EP 0 179 147) .

As to claims 19-22, 38 and 41; **Levine et al** discloses a touch screen which display an image but failed to teach that the display object is a rollable type. The patent of **CHARWAT** clearly teaches that it is well known for a touch screen display system to display the image in a rolling condition (see, pages 1, last paragraph to page 2).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have incorporated the system rolling an image as taught by **CHARWAT** into the device of **Levine et al** since this an alternative way of scrolling an image.

12. Claims 13,14,83-90 rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al** (55,060,135) in view of **Santo et al** (4,947,156) and **Murasaki et al** (5,867,158).

In regard to claims 13,14,83-90, **Levine et al** discloses a touch screen display device with a touch detection system but failed to disclose scrolling the image. However, Murasaki et al suggests scrolling of the display image in a different direction and between the reference position (see, Abstract, col.5, lines 43-54, col.7, lines 27-55).

Therefore, it would have been obvious to one of skill in the art at the time of the invention was made to have combined the touch display of **Levine et al** with a scrolling methods of Murasaki et al, so that the image displayed by **Hagiuda** can be scrolled easily to view more of the displayed images.

13. Claims 91 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al** (55,060,135) in view of **Santo et al** (4,947,156), **Ohuchi** (4,903,012). and **Takahashi (4,954,967).**

As to claims 91 and 100, Levine as modified by Santo et al and Ohuchi discloses a computer readable medium storing but has failed to disclose that the touch contact scrolls at a predetermined

speed. Takahsasi suggest that it is well known to have a predetermind scrolling speed for a touch contact object (see, Abstract, col.3, lines 25-47).

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to have combined the use of predetermined scrolling speed of touched object into the system of **Levine et al**, since this an advantage to Levine's system to control the moving direction of the displayed object.

Allowable Subject Matter

14. Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. *Any inquiry concerning this communication should be directed to Amare Mengistu at telephone number (703) 305-4880.*

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

A. Mengistu

Art unit 2673

Oct.21,2001

Amare Mengistu
Primary Examiner